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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,229	05/02/2001	Herbert R. Burnham		7400

7590 08/08/2005

Herbert R. Burnham  
2252 Boulder Creek Street  
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EXAMINER
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REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/846,229

Applicant(s)

BURNHAM, HERBERT R.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004 and 24 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

1. The following action on the merits is based on various portions of Applicant's various responses as follows: the proposed three sheets of drawings filed 3-24-05, the proposed substitute specification filed 5-5-03 including the abstract and the marked up specification filed 5-5-03, the substitute declaration filed 8-6-05, claims 8-10 filed 3-24-05, the 3-24-05 proposed amendment to the substitute specification and the remarks/observations filed 8-4-04 and 3-24-05.

### ***Specification***

2. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.

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- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### **Content of Specification**

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.  
  
Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.
- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

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- (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the

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international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

### ***Oath/Declaration***

3. The oath or declaration filed 8-6-04 is accepted.

### ***Drawings***

4. The drawings were received on 3-24-05. These drawings are not approved by the Examiner. The drawing changes are not approved because contrary to Applicant's remarks they still were neither labeled as "Replacement Sheets" nor "Annotated Sheets showing Changes", i.e. still not in compliance with 37 CFR 1.121. Furthermore the pages were labeled "Page 4 of 16", etc., rather than, e.g., 1/3, 2/3, 3/3. Note paragraph 6 *infra*. The Figures still do not agree with the text, i.e. of the originally filed specification, i.e. a Figure 3 is not described at all, the breakaway ties, i.e. the element labeled 201 in proposed Figure 3, is described as being not shown, the numerals 102 and 103 still do not denote the waist and legs as described. Also, where is the support for the element 201 as shown, i.e. where is it disclosed that the element 201 is at the end as shown (It is noted that since such element is not claimed it does not have to be shown in the Figures. However if it is shown, it needs to be supported by the originally filed specification). Therefore the drawings considered to be pending in the application are still those originally filed. Note the following paragraph.

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5. The drawings of 5-2-01 are objected to because 102 and 103 do not denote the waist and legs of the user as described but rather the waist and leg surrounding portions of the diaper. In Figure 1, the numerals 107 and 111 appear to denote the same structure. In Figure 2, 109 denotes the page or space not the pad. The line from 112 should extend all the way to the structure it denotes. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Description***

6. The substitute specification filed 5-5-03 still has not been entered because the marked up copy does not show all the changes made to the original to arrive at the text of the clean copy of the substitute specification. For example, compare page 3, line 4 of the marked up copy with

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page 3, line 10 of the clean copy of the substitute specification, i.e. numeral 103. Also the substitute specification appears to include new matter, i.e. page 3, lines 13-15 of the substitute specification, i.e. where is the use of no more than five or six pads disclosed in the original specification, i.e. Applicant is now setting forth that the number of pads can't exceed six pads but originally disclosed that it could included more than six pads, i.e. the terminology "multiplicity" means any number more than one. Where is the subject matter of page 4, last two lines of the marked up specification now set forth? The amendment to the specification filed 3-24-05 also could not be entered because it still does not comply with 37 CFR 1.121 because it does not show the markings made to the last accepted text, in the instant case the originally filed application, to arrive at the new text, i.e. new language underlined and deleted language struck through. Therefore, the specification including the abstract considered to be pending in the application are still those originally filed. Note the following paragraphs.

7. The abstract of the disclosure filed 5-2-01 is objected to because legal terminology, i.e. "comprising", "means for", "said" and terminology which can be inferred, i.e. "The invention is", should be avoided. On line 12, "puling" should be --pulling--. Correction is required. See MPEP § 608.01(b).

8. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.



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The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

9. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

10. The disclosure filed 5-2-01 is objected to because of the following informalities: 1) A summary of the Invention section, i.e. a description of the claimed invention, is not present, see MPEP 608.01(d) and 1302.01. On page 2, lines 18-19 are inaccurate and inconsistent with page 3, line 5. 3) On page 2, line 20, "pads104" should be --pads 104--. 4) On page 2, line 23, "set" should be --stack--. This also applies to page 3, line 21. 4) On page 2, fourth line from the bottom-page 4, last line various embodiments are discussed. Which of these embodiments do the drawings show? Where is this clearly set forth in the Detailed Description? Are Figures 1 and 2 the same article? 5) What includes the guides or folds 110? The stack 104? The outer sheet?

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Each pad? What causes the guides or folds? Should such also be shown in the sectional view of Figure 2?

Appropriate correction is required.

### ***Claim Language Interpretation***

11. The means plus function language “closure means...pad” in claim 10 invokes 35 USC 112, sixth paragraph, because it sets forth a “means plus function” limitation without reciting sufficient structure to perform such function, i.e. limited to the corresponding structure, materials or acts described in the specification and equivalents thereof. However since the limitation is not supported by corresponding structure, material or acts in the specification disclosure, see discussion infra, an equivalent is any element that performs the specified function. The means plus function language “internal absorbent means” in claim 8 is not considered to invoke 35 USC 112, sixth paragraph, since sufficient specific structure, i.e. the set of pads, of the means is set forth.

### ***Claim Rejections - 35 USC § 112***

12. Claims 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 8, it is unclear how many openings and bags are associated with each pad. See Suggested Claim Language section infra. Also the claim 10 is indefinite because the element or step set forth by the means plus function terminology, i.e. “closure means...pad” in

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claim 10, is not defined in the specification by corresponding structure or material. See Response to Arguments section infra.

***Suggested Claim Language***

13. The claims could be rewritten as follows to be in better form as well as overcome the 35 USC 112 rejection of claim 8 in the preceding paragraph:

8. (Currently Amended) A multi-use diaper consisting of an outer impermeable shell shaped to fit a user, a predetermined number of individually disposable, absorbent pads stacked on top of each other within the shell for removal in sequence from top to bottom of the stack as the topmost pad becomes wet or soiled, and a plurality of disposal bags equal in number to the predetermined number of pads, wherein the shell includes an individual removal opening therethrough for each of said absorbent pads and each of the disposal bags interconnecting one of said removal openings and one of said pads so as to enclose said one of said pads therein as said one of said pads is removed through said one of said openings.

9. The diaper of claim 8 wherein each pad includes a bottom layer of impermeable material and a tongue for grasping which protrudes through the individual removal opening therefor.

10. The diaper of claim 8 wherein each disposal bag is affixed at an end to said one of said pads and at another end to said one of said removal openings and has a tear-away area and closure means to seal-in the enclosed said one of said pads.

***Allowable Subject Matter***

14. Claims 8-10, as best understood, see paragraph 13 supra, patentably distinguish over the prior art of good date.

***Response to Arguments***

15. Applicant's observations/remarks of 8-6-04 and 3-24-05 have been considered but are either deemed moot in that the issue discussed has not been reraised or deemed not persuasive for the reasons set forth supra. It is specifically noted that contrary to Applicant's 8-6-04 and 3-24-05 arguments, e.g. in the 8-6-04 reponse the last paragraph on page 1, the requirement is not for antecedent basis for the terminology "closure means...pad" but rather a description of the structure or acts which correspond to such language, see MPEP 2185.

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant's copies of correspondence have been noted. Such correspondence appears to have taken place after the filing of the instant application. It is noted that one letter addressed to Kimberly-Clark appears to be dated just shortly after filing the application, i.e. 5/10/01, and refers to a prior communication therebetween but does not specify when such took place nor whether such contact related to merely procedures of submitting ideas or whether specific ideas were discussed. Applicant is requested to provide clarification as to such in the next response, if any.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any new grounds of rejection were necessitated by the amendments submitted by Applicant on 8-6-04 and 3-24-05.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karin M. Reichle  
Primary Examiner  
Art Unit 3761

KMR  
August 4, 2005